

I. THE CLAIMS DEFINE ALLOWABLE SUBJECT MATTER

The Office Action rejects claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,075,787 to Shaughnessy (hereinafter "Shaughnessy"). This rejection is respectfully traversed.

Regarding claims 1 and 10, the Office Action asserts that Shaughnessy discloses a system and method of processing image data of a color image for marking wherein the color image containing overmarked pixels where at least one first color is to be overmarked by a second color comprising means for or steps of generating information that designate the overmarked pixels; performing image processing to create an image of the color image, the image processing including overmarking processing that allows both the at least one first color and the second color to be included in the overmarked pixels in the image and modifying image data of the overmarked pixels in the raster image.

The Office Action admits that Shaughnessy does not disclose that the image processing is a raster image processing to create a raster image of the color image, as claimed in claims 1 and 10. The Office Action asserts that Shaughnessy teaches that the system is an electro-photographic reproduction apparatus or a copier for reproducing an original document sheet wherein the original is scanned to provide respective output signals which are processed to produce signal sets representing the boundaries of the first and second loops, and reproducing upon a record sheet the portion of the image information in one of the two areas while not reproducing image information within the other. The Office Action further asserts that it was commonly known in the art that a conventional electro-photographic reproduction apparatus or copier device can perform raster image processing to create a raster image. The Office Action further asserts that it would have been obvious to one skilled in the art at the time the invention was made to consider the system or method in Shaughnessy performs rasters image processing

since the system scans the original image data and converts it to bit stream of digital data which is coded and processed for reproduction or transmission.

Applicants respectfully traverse this assertion. Shaughnessy discloses an apparatus and method for producing selectively edited reproductions of an original document where areas of information on the original document are bounded and alphanumerically character-coded with the use of a highlighting means to designate the area for editing. (see Abstract in Shaughnessy).

Shaughnessy does not disclose, teach or suggest performing raster image processing to create a raster image of the color image, the raster image processing including overmarking processing data allows both to at least one first color and a second color to be included in the overmarked pixels in the raster image, as recited in claim 1. Further, Shaughnessy does not disclose, teach or suggest a raster image processor that creates a raster image of the color image, the raster image processor provided with an overmarking function that allows both to the at least one first color and the second color to be included in the overmarked pixels of the raster image, as recited in claim 10.

As required by MPEP §706.020(j), to establish a *prima facie* case of obviousness, these basic criteria must be met:

- 1) There must be some suggestion or motivation in the references themselves or in the knowledge generally available;
- 2) Reasonable expectation of success;
- 3) The prior art reference must teach or suggest all claim limitations.

The first and third requirements have not been met by the rejections of the Office Action. Shaughnessy fails to show any motivation to modify the structure to achieve the claimed invention, and the Office Action clearly admits that there is one or more essential parts of the claimed invention missing in Shaughnessy.

For at least these reasons, it is respectfully submitted that independent claims 1 and 10 are distinguishable over the applied art. Claims 2-9 and 11-22, which depend from independent claims 1 and 10, are likewise distinguishable over the applied art for at least the reasons discussed as well as for the additional features they recite. Withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

II. CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that the this application is in condition for allowance.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachment:

September 1, 1999 Information Disclosure Statement

Date: May 22, 2002

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